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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,272

10/12/2005

Koji Okada

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26021 7590 05/05/2008

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

05/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,272	Applicant(s) OKADA ET AL.	
	Examiner Cynthia Hamilton	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/10/08, 02/08/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/10/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The information disclosure statement filed April 10, 2008 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because with respect to Non-Patent Literature Document applicants failed to identify by date the paper or papers given as well as to separate papers according to document. This document(s) was crossed out for this reason. All other documents were considered as initialed. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

2. With respect to Information Disclosure Statement filed April 10, 2008, Ishigaki et al (US 2007/0218305) has as an oldest possible effective filing date for 35 USC 102(e) purposes of April 30, 2004. The actual International publication related thereto is WO 2005/103822 A2 with a filing date of April 21, 2005 when matching of International Application Numbers is performed. The cited related applications are too old to establish an effective filing date pre April 30, 2003 as all were filed in 2001. Thus, the oldest date possibly available for Ishigaki et al is April 30, 2004. WO 2005/103822 A2 shows Provisional document 60/566,893 with a filing date of 30 April 2004 as a priority document for this application. WO 2005/103822 A2 is made of record.

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3. With respect to documents related to JP 2003-084429 A, the oldest related document in English is WO 2003/00516 A1 which is the International Publication of Tamura et al (US 7,195,857 B2 and US 2004/0009428 A1) and has an earlier publication date than JP 2003-084429 A. WO 2003/00516 A1 is made of record and is noted to have a publication date of January 16, 2003.

4. PTO 08-0293 is made of record as an English translation of JP 2002-317022 A and PTO 08-0296 is made of record as an English translation of JP 2000-147768 A.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In lines 5-6 of claim 10 is found "having at least either a hydroxyl group, and the (meth)acrylic compound.....". The use of either indicated at least two choices. Since lines 2-3 reference both (A) and (B) being present then the other choice is apparently not the (meth)acrylic compound. Because of this, it is unclear whether part of claim 10 is missing or the use of either is confusing. Thus, claim 10 is held unclear. For examination purposes, the examiner has taken only the presence of hydroxyl group as a claim limit as nothing else is present. The examiner also notes again that hydroxyl group is inclusive by applicant's disclosure as set forth in the last Office Action as inclusive of any group with an -OH present. See page 36 of the original specification.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 10 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Koyanagi et al (JP 2002-317022 A) as evidenced by PTO 08-0293. With respect to instant claims 10 and 21, Example 2 of Koyanagi et al as found in PTO 08-0293 anticipates both instant compositions wherein resin (A-2) is a polyimide resin with acid groups thus hydroxyl groups as defined by applicants in their specification as evidenced by resin (A-2) having an acid number as found in [0092] last line and resin (C-1) being comprised of having an acid value and thus at least -COOH groups present and if these are considered to contain hydroxyl groups as -OH is present as applicants define such on page 36 of their specification.

9. Claims 10 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ube Ind LTD (JP 10-265571 A as evidenced by attached English translation thereto by applicants). If instant components (A) and (B) are the same compound, then the compositions of Ube Ind LTD anticipate the instant composition as the polyimide resin when reacted with glycidyl acrylates yields the same compound as if reacted with acrylic acid when instead of -OH groups, glycidyl groups would be present. Both reactions yield the -OH group and epoxy acrylates with more than two hydroxy groups thus reading on the polyimide with hydroxyl groups for instant (A) and the epoxy (meth)acrylate of instant (B). See particularly [0061].

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cynthia Hamilton/
Primary Examiner, Art Unit 1795

April 18, 2008